

PATENT COOPERATION TREATY

PCT

NOTIFICATION OF ELECTION

(PCT Rule 61.2)

From the INTERNATIONAL BUREAU

To:

United States Patent and Trademark
Office
(Box PCT)
Crystal Plaza 2
Washington, DC 20231
ETATS-UNIS D'AMERIQUE

in its capacity as elected Office

Date of mailing (day/month/year) 24 February 1998 (24.02.98)	
International application No. PCT/EP97/03329	Applicant's or agent's file reference 12/182-PCT
International filing date (day/month/year) 25 June 1997 (25.06.97)	Priority date (day/month/year) 28 June 1996 (28.06.96)
Applicant CZERNILOFSKY, Armin, Peter et al	

1. The designated Office is hereby notified of its election made:

☒ in the demand filed with the International Preliminary Examining Authority on:

27 January 1998 (27.01.98)

☐ in a notice effecting later election filed with the International Bureau on:2. The election ☒ was☐ was not

made before the expiration of 19 months from the priority date or, where Rule 32 applies, within the time limit under Rule 32.2(b).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Authorized officer Ann Bardini
Facsimile No.: (41-22) 740.14.35	Telephone No.: (41-22) 338.83.38

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Date of mailing (day/month/year)

27 November 1998 (27.11.98)

International application No.

PCT/EP97/03329

International filing date (day/month/year)

25 June 1997 (25.06.97)

Applicant

BOEHRINGER INGELHEIM INTERNATIONAL GMBH et al

The International Bureau transmits herewith the following documents and number thereof:

_____ copy of the English translation of the international preliminary examination report (Article 36(3)(a))

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Facsimile No.: (41-22) 740.14.35

Authorized officer

R. E. Stoffel

Telephone No.: (41-22) 338.83.38

Translation

PATENT COOPERATION TREATY

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INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 12/182-PCT	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/EP97/03329	International filing date (day/month/year) 25 June 1997 (25.06.1997)	Priority date (day/month/year) 28 June 1996 (28.06.1996)
International Patent Classification (IPC) or national classification and IPC G01N 33/50		
Applicant BOEHRINGER INGELHEIM INTERNATIONAL GMBH		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

☐ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of _____ sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☒ Certain observations on the international application

Date of submission of the demand 27 January 1998 (27.01.1998)	Date of completion of this report 07 October 1998 (07.10.1998)
Name and mailing address of the IPEA/EP European Patent Office D-80298 Munich, Germany Facsimile No. 49-89-2399-4465	Authorized officer Telephone No. 49-89-2399-0

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP97/03329

I. Basis of the report

1. This report has been drawn on the basis of (Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.):

- ☐ the international application as originally filed.
- ☒ the description, pages 1-56, as originally filed,
pages _____, filed with the demand,
pages _____, filed with the letter of _____,
pages _____, filed with the letter of _____.
- ☒ the claims, Nos. 1-27, as originally filed,
Nos. _____, as amended under Article 19,
Nos. _____, filed with the demand,
Nos. _____, filed with the letter of _____,
Nos. _____, filed with the letter of _____.
- ☒ the drawings, sheets/fig 1/7-7/7, as originally filed,
sheets/fig _____, filed with the demand,
sheets/fig _____, filed with the letter of _____,
sheets/fig _____, filed with the letter of _____.

2. The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/fig _____

3. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

4. Additional observations, if necessary:

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V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims		YES
	Claims	1 - 27	NO
Inventive step (IS)	Claims		YES
	Claims	1 - 27	NO
Industrial applicability (IA)	Claims	1 - 27	YES
	Claims		NO

2. Citations and explanations

1. The methods for comparative "screening" of pharmacologically active substances as claimed in Claim 1 are disclosed in the following documents cited in the search report:
WO-A-93/11257 describes a method for "screening" substances which have a modulating effect on a receptor-dependent signal-transmission path in mammalian cells. The test cells used are transformed with a reporter gene and a regulatory sequence functionally connected thereto which responds to the IP₃/DAG concentration and with a DNA which encodes a receptor coupled to the phospholipase effector system, more particularly a G-protein-coupled receptor. The use of control cells which lack receptor DNA and control cells with specificity for the adenylate cyclase effector system enables substances with a potential pharmacological activity which have specificity for a particular receptor-dependent signal-transmission path to be identified (see Claims 1 - 10).
WO-A-92/13063 describes methods for testing substances as effectors of the transcription of growth factor receptors which have the features of Claim 1 (see Claims 67 - 69).

.../...

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(Continuation of V.2)

The subject matter of Claim 1 is therefore novel within the meaning of PCT Article 33(2).

2. Even if the applicants were able to rebut the above-mentioned objection of lack of novelty, an objection of lack of inventive step would have to be raised concerning the subject matter of Claim 1 (PCT Article 33(3)).

The invention is obvious: it does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e., the methods claimed in Claim 1 do not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art.

3. The subject matter of dependent Claims 2 - 27 does not appear to contain any additional features which, in combination with the features of Claim 1, could yield a subject matter which is novel and involves an inventive step (PCT Article 33(2) and (3)).

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VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

1. (German text only) The term "bzw." used in Claim 2 is vague and obscure and makes the subject matter of the claim unclear (PCT Article 6). Expressions of this kind have no limiting effect on the scope of a claim, i.e., the feature following any such expression should be regarded as entirely optional (PCT Preliminary Examination Guidelines, PCT/GL3/C-III, 4.6).